

REMARKS

Applicant adds new claims 11 and 12; therefore, claims 1-12 are all the claims pending in the application.

Applicant amends claim 9 to recite the feature of a trigger signal, and adds new claims 11 and 12, which are analogous to claim 8, but depend on claims 9 and 10, respectively.

The Examiner rejects claims 1, 2 and 4-10 under 35 U.S.C. § 103(a) as being unpatentable over Goldstein in view of Borgstahl et al. (Borgstahl). The Examiner indicates that claim 3 would be allowable if rewritten in independent form including the limitations of the base claim and any intervening claims.

Applicant respectfully traverses the rejection of claims 1, 2 and 4-10 as follows.

As explained in Applicant's Amendment filed February 5, 2003, Response filed August 21, 2003, and Brief on Appeal filed January 21, 2004, Applicant's claimed invention defines a system, a controller, a remote control, and a method for controlling the system, which comprise unique combinations of features. These features include, *inter alia*, a remote control unit comprising a control-unit-sender for sending a control-signal for remotely controlling at least one device, and a controller-sender incorporated into a controller (which is coupled to a network and controls at least one device) for sending an interface to the remote control unit in response to a trigger-signal (see Applicant's independent claims 1, 7, 9 and 10). Goldstein and Borgstahl (applied in any reasonable combination) do not teach or suggest such unique combinations of features.

The Examiner acknowledges that Goldstein does not disclose the feature of a “trigger signal” as recited in independent claims 1, 7, 9 and 10, and relies on Borgstahl as allegedly supplying this acknowledged deficiency of Goldstein (see Office Action, page 3).

Borgstahl discloses an interactive appliance remote controller for use in a personal area network, particularly in a “peer-to-peer data communication network” (see Id., col. 3, line 65 through col. 10, line 41), where:

Controller 300 [interactive appliance remote controller] ... requests that a command set for controlled object 324 be downloaded (block 330).

and

Controlled object 324 then downloads (download "set of control commands" 332) a set of such commands to controller 324 [sic., controller 300]. At this point, controlled object 324 has sent a set of commands/actions that it can perform at the behest of controller 300.

(See Borgstahl, col. 16, lines 33-46).

The Examiner alleges that “[i]t would have been obvious to one of ordinary skill in the art for the controller to send an interface in response to a trigger-signal to the remote control in Goldstein ... because Goldstein suggests sending an interface to a remote control from the controller and Borgstahl et al. teaches sending an interface to a remote control in response to a trigger signal for initiating the transfer of the interface to the remote control” (see Office Action, page 3).

Applicant respectfully disagrees with the Examiner’s analysis, and submits that one of ordinary skill in the art of programmable remote controllers would not have been motivated to combine the opposing teachings of Goldstein and Borgstahl.

In particular, Borgstahl discloses a system where a control set for programming an appliance in a personal area network is downloaded to the remote controller from the appliance to be controlled by the remote controller (see Id., Abstract). That is, rather than receiving interface information for controlling an appliance from a “program originating facility”, as taught by Goldstein (see Goldstein, col. 12, lines 23-26), Borgstahl teaches a system where a remote controller receives the interface information for controlling an appliance from the appliance itself. In fact, the Examiner does not provide any reasoning as to why one of ordinary skill in the art would have been motivated to modify Goldstein’s remote control device 5, which receives its programming from a program origination facility via the cable converter 6, to include the feature of sending a download request, as describe in Borgstahl, to the cable converter 6.

Thus, when considering the disclosure of Goldstein and Borgstahl as a whole, one of ordinary skill in the art of programmable remote controllers would not have been motivated to combine the opposing teaching of these two references, let alone combine these teachings in a way proposed by the Examiner, without the benefit of Applicant’s own disclosure. *See* MPEP §2141.02 (prior art must be considered in its entirety, including disclosures that teach away from the claims); *see also* MPEP §2145(X)(D)(2) (“[i]t is improper to combine references where the references teach away from their combination” *citing In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)).

Thus, Applicant’s independent claims 1, 7, 9 and 10, as well as the dependent claims 2, 4-6 and 8 (which incorporate all the novel and unobvious features of their base claims) would not

have been obvious from any reasonable combination of Goldstein and Borgtahl at least for the reasons set forth above.

With regard to claim 5, which recites a telecommunication system where “ said controller comprises a controller-detector for detecting an interface-amendment, whereby said controller-sender is adapted for sending a request-signal destined for said remote control unit, and said control-unit-receiver is adapted for receiving said request-signal, whereby said control-unit-sender is adapted for sending said trigger-signal in response to said receiving of said request-signal”, the Examiner alleges that Goldstein teaches such a feature at col. 12, lines 23-27 (see final Office Action, page 4).

As explained in Applicant’s Brief on Appeal filed January 21, 2004, Goldstein teaches nothing more than that data received from a remote origination facility by cable converter 6 may be transmitted to remote control 5. Such a generic data download feature does not in any way teach or suggest detecting interface amendments and sending request signal and trigger signal, as claimed in Applicant’s claim 5, to, for example, effectively update a previously downloaded interface if an interface amendment is detected. Col. 12, lines 23-33 of Goldstein are reproduced below for reference:

The bidirectional communications link 30, 31 permits data that is received from the program origination facility to be transmitted from the cable converter 6 to the universal remote control 5. Thus, advertising messages, a complete operating system, infrared codes for operating the various equipment in the consumer's home, telephone numbers for initiating phone calls from the converter over the local area network, and icons for display on a touch-sensitive screen 68, as well as audio messaging, may all be received over the bidirectional communications link from a cable converter 6. (Id.)

The Examiner alleges that Goldstein's controller "inherently has a means of detecting such amendments in order to know when to transmit such information to the remote control". (see Office Action, page 4). Applicant respectfully disagrees. Nowhere does Goldstein disclose, or even remotely suggest receiving, detecting, or transmitting an interface-amendment. In fact, in the very portion cited by the Examiner, Goldstein teaches a remote controller receiving "a complete operating system" over bidirectional link 30,31 between the remote controller and a cable converter 6 (see Goldstein, col. 12, line 27, emphasis added). Thus, the Examiner's "inherency" argument is not supported by Goldstein, and is contrary to well established legal principles. *See Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int.) ("In relying upon theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art", original emphasis). Accordingly, the Examiner's position that Goldstein's controller "inherently has a means of detecting such amendments in order to know when to transmit such information to the remote control" is without merit. *See In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic); *see also* MPEP §2112 at 2100-40.

Thus, Applicant's claim 5 would not have been obvious from the combination of Goldstein and Borgstahl for this additional reason.

With regard to claim 8, which recites a trigger-signal comprising either a first code for indicating a first device or a second code for indicating a second device, the Examiner alleges

that the combination of Goldstein, which describes “personalized” IDs for remote controllers, e.g., IDs for remote controllers used in “bedroom or family room” (see Id., col. 5, lines 1-5), and Borgstahl, which describes a remote controller that “requests that a command set for controlled object 324 be downloaded” (see Id., col. 15, lines 41-43), teaches this features. Applicant respectfully disagrees.

That is, Goldstein’s “personalized” ID, assigned to the remote controller by a cable converter, has nothing to do with Borgstahl’s “request”, sent to a controlled object by a remote controller to download a command set for the controlled object sent. Clearly, one skilled in the art of programmable remote control units would not arrive at a trigger-signal which includes a code for indicating a device to be controlled by a remote controller based on the unlikely combination of the teaching of sending a request to the controlled object (Borgstahl) and the teaching of assigning an ID to the remote controller (Goldstein).

Thus, Applicant’s claim 8 would not have been obvious from Goldstein and Borgstahl for this additional reason.


In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111
Appln. No.:09,619,910

Atty Dkt No. Q59816

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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